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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,840	01/12/2000	Michael Robert Hanson	04860.P1712C	6190

7590 09/25/2002

Blakely Sokoloff Taylor & Zafman
12400 Wilshire Blvd
Seventh Floor
Los Angeles, CA 90025

EXAMINER

FEILD, JOSEPH H

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/481,840	Applicant(s) HANSON ET AL. <i>HB</i>	
	Examiner JOSEPH H FEILD	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14 and 16-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14 and 16-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Please note that Grant Yang, formerly in charge of examining this application, is no longer employed by the USPTO. Please update future correspondence to reflect that Joseph Feild, Art Unit 2176, will be examining this application.

Non-Publication

2. Receipt of the Request for non-publication has been acknowledged.

Continued Prosecution Application

3. The request filed on 7/9/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/481,840 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 14 and 16-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to each of the independent claims 14, 20, and 31, "objects panel" and "defined objects panel" are claimed. There is, however, no apparent distinction between "objects" and "defined objects" because inherently, all "objects" must be defined. Clear terminology must be employed to provide a distinction.

Art Unit: 2176

With regard to dependent claims 16, 23-24, and 33-34, further confusion is added by employing the term "predefined objects". However, once the independent claims are properly amended, claim 16 will probably become clear.

The remaining dependent claims are rejected for fully incorporating the deficiencies of the base claim(s) from which they depend. Applicant should carefully review each of the dependent claims once the independent claims are amended in order to provide proper antecedent basis for all claims.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 14, 16-21, 25-31, and 35-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,956,736. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Independent claims 14, 20, and 31 (and dependent claim 16) correspond with patented claims 1 and 5. One difference between the claims of the instant application and the patented claims is that the patented claims recite “defined objects” and “predefined objects” or “user-defined objects”. (Note: claim 16 of the instant invention includes “predefined objects”). As is argued above under §112, 2nd paragraph, the instant claims are vague and indefinite because there is no apparent distinction between “objects” and “defined objects”. Thus, it appears that the difference between the instant claims and the patented claims amounts to the difference between vaguely recited subject matter and clearly recited subject matter. Thus, there exists an unpatentable distinction between the instant claims and the patented claims.

Another difference between the sets of claims is that in patented claim 1 (column 15, lines 16-18), “at least one object” is “**selected** from one of said list . . . “. In claim 14 of the instant invention, “one object” (not “at least one”) is displayed, but “selected” is not recited. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to only recite “one object” because of the open-ended language employed (“comprising”), which would allow for one or more than one. Furthermore, it would have been obvious to omit the word “selected” because there is an implied selection anyway—the object got there somehow since it comes from the “list of defined objects and the list of objects”.

Claims 17-18 correspond with patented claims 2-3.

Claim 19 corresponds with patented claim 4.

Art Unit: 2176

Claim 21 corresponds with patented claim 6.

Claim 25-30 correspond with patented claims 7-12, respectively.

Claims 35-37 correspond with patented claims 7-9, respectively.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 14 and 16-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan et al (5,745,113).

With respect to independent claims 14, 20, and 31, and dependent claims 17-18, 21-22, 25-30, 32, and 35-37, Jordan discloses a user interface which allows a user to

Art Unit: 2176

edit, manipulate, and define objects to create new ones. Refer to Jordan's abstract, figures 2 and 3, and column 6 (line 15) through column 8 (line 7). Jordan discloses a map editor, which allows a user to create a map. Specifically, at column 6 (lines 30 et seq—with reference to figure 2), Jordan discloses, *To add to a map, a user will select an object type from a palette of objects 30 and place it in the map drawing pane 32, creating an instance of the object type. There the object can be positioned, resized, duplicated, grouped with other objects to form larger objects, aligned with another object[ed], deleted, and so on.* At column 6 (lines 40 et seq), Jordan further discloses, *The map editor has a number of predefined types of objects that might be found in typical office settings . . . The objects appear in palettes, a limited number of which may be selected by the user to appear on the map editor window. A user may create new objects and palettes at any time.* At column 7 (lines 19 et seq—with reference to figure 3), Jordan discloses, *an object editor, invocable as a menu item, allows a user to create new types of display objects (user-defined map object types) or modify existing ones. Through dialog boxes, the user selects an existing or new object, edits how it is displayed on a map, edits the icon used for it on palette buttons, specifies the types of record in the database that objects of the type can point to, renames it, or removes it.*

Thus, Jordan teaches a “palette window” at figure 2 (left side) and figure 3 (left side), which comprises a “panel” that includes “defined objects” (top left). Jordan discloses a “view window” at the right side of both of figures 2 and 3. An “input device” (mouse or keyboard—see figure 1) is used to select and manipulate objects. Jordan also discloses a *PALETTE SET POP-UP* in figure 2, which includes an arrow that

evidently provides more selections than the illustrated *Basic Set*. It is noted that Jordan does not explicitly teach that the "palette window" comprises both a "defined objects panel" and an "objects panel". However, such a "palette window" would have been obvious to one of ordinary skill in the art at the time of the invention in view of Jordan's disclosure at figures 2 and 3 because the palette window shown in figure 2 changes to the palette in figure 3 based on the current editing mode. Thus, the "palette window" **functionally** does include both a "defined objects panel" and an "objects panel".

With regard to dependent claims 16, 23-24, and 33-34, Jordan illustrates "predefined objects" at the top left side of each of figures 2 and 3.

With regard to dependent claim 19, refer to Jordan's figure 5, in which a "list of properties" is illustrated in an "object editor window".

Response to Arguments

10. Applicant's arguments with respect to claims 14 and 16-37 have been considered but are moot in view of the new ground(s) of rejection.

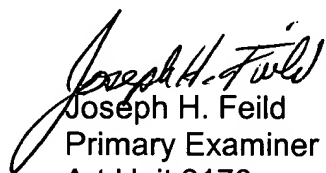
Art Unit: 2176

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH H FEILD whose telephone number is (703) 305-9792. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HEATHER HERNDON, can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are:

(703) 746-7238	(After Final Communication)
(703) 746-7239	(Official Communication)
(703) 746-7240	(Status Inquiries, Draft Communication).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Joseph H. Feild
Primary Examiner
Art Unit 2176
September 20, 2002